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Paper No. 17

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In re Application of	:	
Mitchell Bauer	:	
Application No. 09/556,647	:	PETITION TO WITHDRAW
Filed: April 24, 2000	:	RESTRICTION
Attorney Docket No.: 8778.00	:	
For: MATERIAL BROWSER	:	37 C.F.R. 1.144

This is in response to applicant's Petition filed on July 23, 2003 to have the Restriction Requirement in the Office action dated December 17, 2002 withdrawn.

The petition is **GRANTED-IN-PART**.

Petitioner argues that the original restriction requirement made by the examiner is improper and sets forth a detailed explanation in their petition as to why the restriction requirement should be withdrawn. With respect to the Group I and II inventions, petitioner argues that claims 1 and 8 clearly show substantial similarity between the method and the corresponding apparatus claims.

An analysis of the restriction requirement and the currently pending claims indicates that restriction between these two groups of inventions was proper but for a different rationale. In this particular case the method of Group I could have been practiced by a materially different apparatus other than that of Group II. Specifically, the method could be performed with an apparatus that does not require that the processor be used to query the users for input but where the data is collected by a person on a telephone querying a user and then keying the data into the processor.

Accordingly, the restriction requirement between Groups I and II is considered proper.

With respect to the restriction requirement between Groups I and III, petitioner argues that the two sets of claims are not subcombination claims but are both combination claims and as such the restriction is not proper.

An analysis of the restriction requirement between Groups I and III and the currently pending claims indicates that the restriction on the basis of subcombinations useable

together in a single combination made by the examiner was proper. Specifically Group I is directed to gathering a user's input and then making a material selection based on the input, and is a sales tool. Group III, on the other hand, is drawn to selecting a material for manufacturing a product and operates on already stored data in order to make selections, which would have applicability as a research tool for a manufacturing company.

Accordingly, the restriction requirement between Groups I and III is considered proper.

With respect to the restriction requirement between Groups I and IV, petitioner argues that the examiner has failed to interpret the claims properly since the claims have been treated as if in a technical vacuum without due regard to the sophisticated functions thereof effected in a computer system.

An analysis of the restriction requirement between Groups I and IV and the currently pending claims indicates that the restriction was made on the basis of a process and an apparatus for its practice and was proper but for a different rationale. In this particular case it is seen that the process could be practiced by a materially different apparatus. For example, the process requires a querying of the user in order to input data while the apparatus has stored data, which could have been loaded by other means.

Accordingly, the restriction requirement between Groups I and IV is considered proper.

With respect to the restriction requirement between Groups II and III, petitioner argues that the grouping of claims is clearly erroneous and lacks technical credibility.

An analysis of the restriction requirement between Groups II and III and the currently pending claims indicates that the restriction was based on a process and an apparatus for its practice and was proper but for a different rationale. Specifically the process of Group III deals with a manufacturing process, which selects a material while the system of Group II requires the querying of the users for data input. Clearly the process of Group III could be used without querying of the users as required by Group II.

Accordingly, the restriction requirement between Groups II and III is considered proper.

With respect to the restriction requirement between Groups II and IV, petitioner argues that restriction is in error since both sets of claims are directed to combination claims.

An analysis of the restriction requirement between Groups II and IV and the currently pending claims indicates that the restriction on the basis of combination and subcombination was not proper, but instead the restriction should have been on the basis of subcombinations useable together in a single combination for the same reasons as set forth in the distinction between Groups I and III, set forth above.

Accordingly, the restriction requirement between Groups II and IV is considered proper.

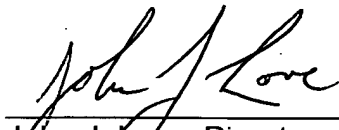
With respect to the restriction requirement between Groups III and IV, petitioner argues that apparatus claim 22 is the means-for equivalent of method claim 15 and that the two groups of inventions should be examined together.

An analysis of the restriction requirement between groups III and IV and the currently pending claims indicates that the maintaining of the restriction requirement in light of the claims as amended was improper.

Accordingly, the restriction requirement between Groups III and IV is hereby withdrawn.

As such, the distinct Groups of inventions are considered to be Group I (claims 1-7), Group II (claims 8-14), and Group III (claims 15-22 and 31-39). Group III being the combination of originally indicated Groups III and IV. Since applicant previously elected Group IV and the above analysis has indicated that Group III was not properly restrictable from Group IV the application will be forwarded to the examiner for the preparation of a supplemental Office action with a treatment of the Group III claims on the merits.

Summary: *Petition Granted-In-Part*



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